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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,051

06/02/2005

John Francis Dufort

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09/05/2008

BLANK ROME LLP

600 NEW HAMPSHIRE AVENUE, N.W.

WASHINGTON, DC 20037

EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,051	<b>Applicant(s)</b> DUFORT, JOHN FRANCIS	
	<b>Examiner</b> Alyssa M. Hylinski	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1,2,7,8,10-17,20,23,24,26,29,30 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8,10-17,20,23,24,26,29,30 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 7-8, 10-11, 20-21, 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister (DE 10013829 A1). Pfister discloses a spinning top and jewelry assembly having a body with a substantially continuous outer perimeter (12) and a stem (11). The stem is movable between a first position where the stem is received within a recess opening in the body such that it is substantially parallel to a main axis of the body (Fig. 1A) and a second position in which the stem extends through the recess opening formed in the body such that it extends in a direction that is perpendicular to the main axis of the body (Fig. 1B). The recess opening extends across substantially the entire body in a direction substantially parallel to the main axis (Fig. 1C). The stem includes an elongated main portion with first and second transverse arm portions formed by pivot pins (119) protruding from the sides thereof that engage holes or recesses (14) in the body to pivotally mount the stem to the body to form a cross-like shape (Figs. 1A & 1B). A profile or outline of the main portion of the stem varies along the length of the stem and is non-circular with a larger cross-sectional area halfway along its length formed by a bulbous portion (Fig. 1D). The main portion of the stem has a pointed tip (114) and a handle portion (112). The body is a substantially

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planar circular disk (Fig. 1B). In regard to the body being a unitary one-piece member, the examiner notes that it would have been obvious to one of ordinary skill in the art to use a one piece construction as opposed to the segmented body shown by Pfister, since such a modification would have merely been a matter of obvious design choice. *See in re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). In regard to the stem having a shape of a cross the examiner further notes that changes in shape are generally held to be within the level of ordinary skill in the art and merely a matter of obvious design choice. *See In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

3. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Heidenreich (1139119). Pfister discloses the basic inventive concept, substantially as claimed, with the exception of an outer element. Heidenreich discloses a circular disk shaped piece of paper with a center hole that functions as an outer element attaching to and extending over a majority of a top part of a body and partially secured by a flange on the body of the toy (page 1 lines 47-53). It would have been obvious to one of ordinary skill in the art from the teaching of Heidenreich to include the outer element in order to incorporate advertising matter onto the toy. The outer element being removably mounted to the top and bottom of the body would have been an obvious matter of design choice to a person of ordinary skill in the art because Applicant has not disclosed that having the outer covering being removable from both the top and bottom of the body provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the covering being permanently

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adhered to just the top of the body because it would allow an advertisement to be easily seen and prevent a person from removing the advertisement at a later time. In regard to the outer element being made of resilient material, examiner notes that the mere selection of known materials as recited in claim 17, on the basis of suitability for the intended use would be entirely obvious. See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Heidenreich with resilient material in order to use a known material suitable for the intended use.

4. Claims 29, 30, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Ebara (5787731). Pfister discloses the basic inventive concept, substantially as claimed, with the exception of first and second latching members extending from the stem and body respectively. Ebara discloses a jewelry element having a rotatable stem member (4) with a latch member (17) in the form of tabs (Fig. 7) that abut against a latch member (Fig. 5) in the form of a tab (11) of the body of the member (Fig. 4) so as to prevent rotation of the stem with respect to the body. It would have been obvious to one of ordinary skill in the art to utilize the locking element of Ebara in order to achieve the predictable result of preventing rotation of the elements.

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Ebara. The references disclose the basic inventive concept, substantially as claimed with the exception of the transverse arm portion extending from the center of the main

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portion of the stem. At the time the invention was made it would have been an obvious matter of design choice to have the arm portion at a center location since Applicant has not disclosed that placing the arm portion at a center location provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the arm portion not being positioned at a center location since it still allows for the stem member to be rotated relative to the body so as to form a top member.

### ***Response to Arguments***

6. Applicant's arguments filed 6/5/08 have been fully considered but they are not persuasive. In regard to applicant's argument that the prior art does not disclose a substantially continuous outer perimeter because the prior art contains a gap the examiner notes that the use of "substantially" in the claim means the element does not have to be completely continuous since "substantially" as disclosed in the Merriam-Webster online dictionary means "being largely but not wholly that which is specified" (<http://www.merriam-webster.com/dictionary/substantially>).

7. In regard to applicant's argument that the proposed modification of Pfister by Ebara would render the device unsatisfactory for its intended purpose, the examiner notes that while Pfister does not disclose a locking device, the addition of a locking device would not make device of Pfister inoperable since the locking mechanism would still allow for rotation between the two configurations and would actually help to retain the members in the desired configurations making the device more stable.

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8. In response to applicant's argument that there is no suggestion or teaching in the references to combine the prior art, the examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711